

REMARKS

Reconsideration of the present application is respectfully requested. Claims 1, 11, and 13 are presently pending. Claims 2-10, 12, and 14-17 have been withdrawn as being drawn to non-elected species. Claims 18-39 have been withdrawn as being drawn to non-elected restricted inventions. Claim 1 has been amended and is the only independent claim.

In the Office Action, the Examiner stated that claims 1, 11, and 13 read upon the elected species (See p. 1, II. 6,7); however, the Examiner rejected claims 1, 3, and 11 (See p. 1, II. 17). It is, therefore, unclear whether claim 3 or claim 13 should be addressed in this response. However, since claims 3 and 13 both depend from independent claim 1, either claim should be patentable based on Applicants' amendments and arguments set forth herein.

In the Office Action mailed January 12, 2006, claims 1, 3, and 11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,384,377 to Weaver (hereinafter, Weaver) and U.S. Patent No. 5,688,899 to Strand et al. (hereinafter, Strand) in view of U.S. Patent No. 3,779,993 to Kibler et al. (hereinafter, Kibler) and U.S. Patent No. 5,378,757 to Blount, Jr. et al. (hereinafter, Blount). In rejecting claims 1, 3, and 11, the Examiner asserted that it would have been obvious to incorporate the toners taught in Weaver or Strand into the coatings of Kibler or Blount to provide their expected coloring properties. Based on the amendments to claim 1 and the arguments provided below, Applicants submit that the Examiners rejection should be withdrawn.

Claim 1 has been amended to specify that the claimed composition is an "aqueous" coating composition that comprises a "water-dispersible" polymer. Support for these amendments can be found in the Application on page 4, lines 1-5.

The toner systems taught in Weaver and Strand are not water-dispersible. Rather, the toner systems of Weaver and Strand are water-insoluble compositions formed by copolymerizing hydrophilic polyesters with hydrophilic anthraquinones. The water-insoluble toner systems of Weaver and Strand would not be compatible with

aqueous coating compositions because they would migrate/settle out of the liquid phase.

The aqueous coatings taught in Kibler and Blount contain water-dispersible polymers. However, Kibler and Blount do not suggest the use of any type of toner system in the aqueous coatings.

Applicants submit that claim 1 is not obviousness over the prior art of record, including Weaver, Strand, Kibler, and Blount, because there would be no motivation to combine the water-dispersible polymers taught in Kibler and Blount with the hydrophilic anthraquinones taught in Weaver and Strand, and then employ the resulting polymers in an aqueous coating. Further, even if one were to combine the water-dispersible polymers taught in Kibler and Blount with the hydrophilic anthraquinones taught in Weaver and Strand, one would not reasonably expect that the resulting composition could be successfully employed in aqueous coatings.

Prior to Applicants discovery, one skilled in the art would not expect that modifying a water-dispersible polymer with a hydrophilic anthraquinone would result in a composition that would be compatible with aqueous coatings. Only with hindsight gleaned from Applicants' disclosure would one would be motivated to copolymerize a hydrophilic anthraquinone with a water-dispersible polymer and have a reasonable expectation that the resulting composition would be compatible with aqueous coatings. However, it is well established that an applicant's disclosure can not be used by the examiner as a blueprint to reconstruct the claimed invention from isolated pieces of the prior art. *Grain Processing Corp. v. American Maize-Prod. Co.*, 840 F.2d 902, 907 (Fed. Cir. 1988). Rather, references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention. MPEP § 2141(II).

Further, prior to the Applicants discovery, one skilled in the art would expect that modifying a water-dispersible polymer with a hydrophilic anthraquinone would render the resulting composition incompatible with aqueous coatings. Thus, one skilled in the art would expect that modifying the water-dispersible polymer of Kibler or Blount with the hydrophilic anthraquinone of Weaver or Strand would yield a polymer that could not be successfully used in the aqueous coatings of Kibler or Blount. It is well established that if a proposed modification to the prior art renders it inoperable or destroys its

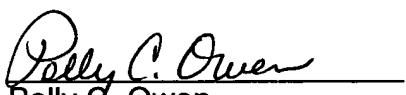
intended function, then the requisite motivation to make the modification would not have existed. MPEP § 2143.01(V).

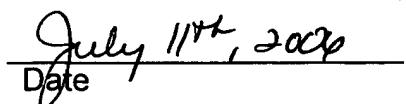
Applicants further submit that none of the cited prior art references teaches the desirability of adding hydrophilic anthraquinones (Strand and Weaver) to water-dispersible polyesters (Kibler and Blount). The mere fact that prior art references can be combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP § 2143.01(III). If the motivation for making the proposed combination is not immediately apparent from the teachings of the prior art, it is the duty of the examiner to present a convincing line of reasoning explaining why the combination of the teachings is proper. MPEP § 2142. In the Office Action, the only rational provided by the Examiner as to why one would be motivated to incorporate hydrophilic anthraquinones with water-dispersible polymers is "to provide their expected coloring properties." Office Action, p. 3, ll. 15,16. However, rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006).

In view of the foregoing, Applicants submit that claims 1, 3, 11, and 13 are patentable over the prior art references.

Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Respectfully submitted,



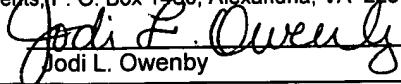
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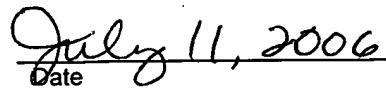
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